

7791-0103-25X CONT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

Michael C. SCROGGIE et al

:

: EXAMINER: ROBINSON-BOYCE, A.

SERIAL NO: 09/505,632

:

CPA FILED: APRIL 4, 2001

: GROUP ART UNIT: 2163

FOR: SYSTEM AND METHOD FOR
DISTRIBUTING INFORMATION...

APPEAL BRIEF UNDER 37 C.F.R. §1.192

ASSISTANT COMMISSIONER OF PATENTS
WASHINGTON, DC 20231

SIR:

This is an appeal from a final Office Action mailed March 9, 2001, rejecting pending Claims 24-31, 34, 36-43, 46, 48 and 49. A Notice of Appeal was timely filed on April 5, 2001. **Proposed Findings of Fact and Conclusions of Law are included as Appendix II herewith. See Gechter v. Davidson, 43 USPQ2d 1030 (Fed. Cir. 1997).**

I. REAL PARTY IN INTEREST

The real party in interest in the present application is the assignee of record, **SUPERMARKETS ONLINE, INC.** 500 West Putnam Avenue, Greenwich, Connecticut 06830.

II. RELATED APPEALS AND INTERFERENCES

Appellants make of record an appeal that is pending in the parent case serial number 08/873,974 and that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 24-31, 34, 36-43, 46, 48 and 49 are pending in the present Appeal. A final Office Action mailed March 9, 2001 rejected Claims 24-31, 34, 36-43, 46, 48 and 49 and is herein appealed.

IV. STATUS OF THE AMENDMENTS

In a final Office Action mailed March 9, 2001, Claims 24-31, 34, 36-43, 46, 48 and 49 were rejected. A Notice of Appeal was timely filed on April 5, 2001. An amendment filed herewith amends Claim 46 to correct a discovered informality and which should be entered. Accordingly, the attached Appendix I reflects Claims 24-31, 34, 36-43, 46, 48 and 49 as they will be pending on appeal.

V. SUMMARY OF THE INVENTION

The present invention is directed to a computer network implemented method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by the manufacturer; in response to the request for manufacturer incentives, transmitting region data from the Web site of the manufacturer over the Internet to a remote Web site; in response to receipt of region data at the manufacturer's Web site, transmitting from the remote Web site to the Web site of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address. See Claims 24, 36 and 48.

The method and system as defined in Claims 24 and 36, wherein the step of transmitting from the remote site further includes transmitting a link to a Web site of the retailer. See Claims 25 and 37.

The method and system as defined in Claims 24 and 36, further includes the step of determining the at least one manufacturer's incentive and the at least one name and address of a retailer by querying, using the region data, a database from a server of the remote Web site. See Claims 26 and 38.

The method and system as defined in Claims 24 and 36, further includes the steps of transmitting from the consumer computer to the Web site of the manufacturer selection data indicating selection of the at least one manufacturer incentive; transmitting from the Web site of the manufacturer to the remote site the selection data; transmitting from the remote site to the Web site of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site of the manufacturer to the consumer computer the details. See Claims 27 and 39.

The present invention is further directed to a computer network implemented method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer; in response to receipt of the request at the Web site of the retailer, transmitting the request from the Web site of the retailer over the Internet to a remote Web site; in response to receipt of the request at the remote site, transmitting from the remote site over the Internet to the Web site of the retailer a list of manufacturer incentives; and in response to receipt of the manufacturers incentives at the Web site of the retailer, transmitting over the Internet to the consumer computer the list of manufacturers incentives. See Claims 28, 40 and 49.

The method and system as defined in Claims 28 and 40, further includes the steps of transmitting a user identification from the Web site of the retailer over the Internet to the remote Web site in association with the request; and determining manufacturer's incentives to transmit from the remote Web site to the Web site of the retailer based upon the user identification. See Claims 29 and 41.

The method and system as defined in Claims 28 and 40, further includes the step of transmitting from the consumer computer over the Internet to the Web site of the retailer region data. See Claims 30 and 42.

The method and system as defined in Claims 30 and 42, wherein the region data is postal code data. See Claims 31 and 43.

The present invention is further directed to a computer network implemented method, and system including transmitting from a manufacturer computer over the Internet to a remote Web site manufacturer incentive data defining manufacturer incentives to purchase one of a product and a service offered by a manufacturer; updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data. See Claims 34 and 46.

In contrast, conventional systems and methods do not disclose nor suggest the above-noted features of the claimed invention. In view of problems inherent with conventional systems and methods, Appellants have discovered an improved computer network implemented method, system, and computer program product, as described above.

VI. ISSUES

(A) Whether one or more of Claims 28, 34, 40 and 46 are anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 5,918,211 to Sloane?

(B) Whether one or more of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49 are unpatentable under 35 U.S.C. §103(a) over Sloane in view of U.S. Patent No. 6,012,039 to Hoffman et al?

(C) Whether one or more of Claims 26, 30, 31, 38, 42 and 43 are unpatentable under 35 U.S.C. §103(a) over Sloane in view of Hoffman et al and further in view of U.S. Patent No. 5,915,243 to Smolen?

VII. GROUPING OF THE CLAIMS

Group 1: For issue (A), Claims 28 and 40 are patentable as argued below and stand or fall together.

Group 2: For issue (A), Claims 34 and 46 are patentable as argued below and stand or fall together.

Group 3: For issue (B), Claims 24, 36 and 48 are patentable as argued below and stand or fall together.

Group 4: For issue (B), Claim 49 is patentable as argued below.

Group 5: For issue (B), Claims 25 and 37 are patentable as argued below and stand or fall together.

Group 6: For issue (B), Claims 27 and 39 are patentable as argued below and stand or fall together.

Group 7: For issue (B), Claims 29 and 41 are patentable as argued below and stand or fall together.

Group 8: For issue (C), Claims 26 and 38 are patentable as argued below and stand or fall together.

Group 9: For issue (C), Claims 30 and 42 are patentable as argued below and stand or fall together.

Group 10: For issue (C), Claims 31 and 43 are patentable as argued below and stand or fall together.

VIII. ARGUMENT

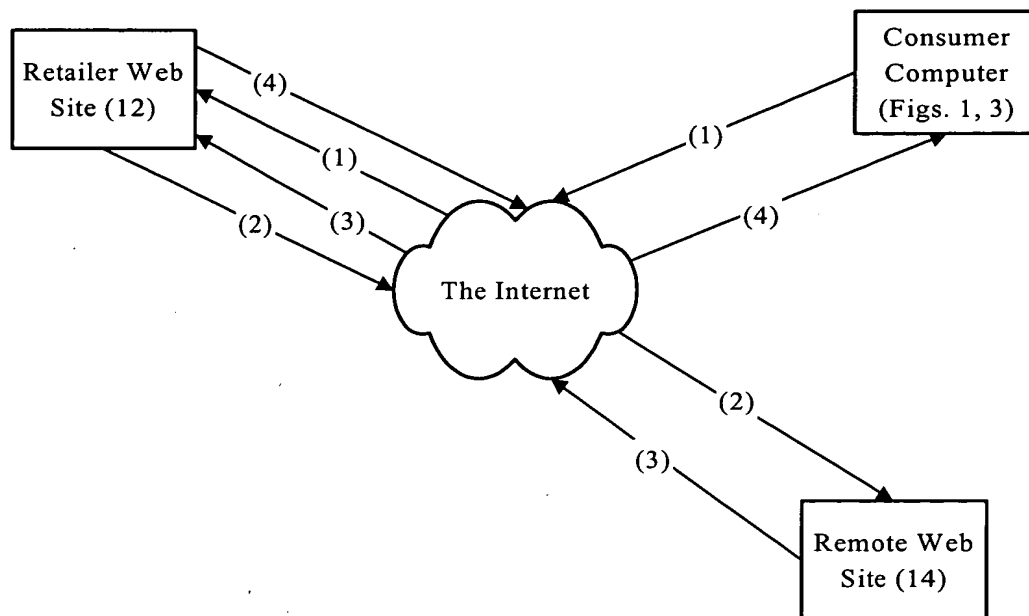
(A) Claims 28, 34, 40 and 46 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,918,211 to Sloane. That rejection is untenable and should not be sustained.

GROUP 1: CLAIMS 28 and 40

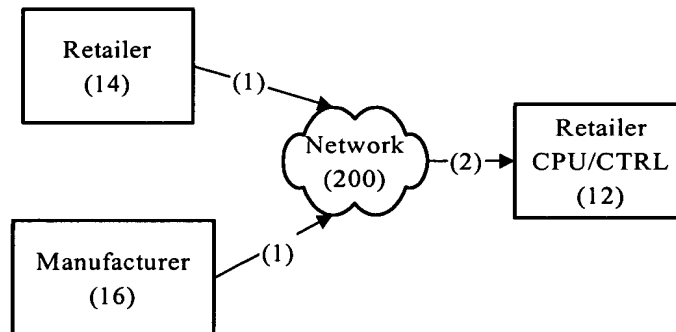
The present invention, as recited in Claims 28 and 40 and as shown in the below exemplary figure, is directed to a computer network implemented method and system including transmitting from a consumer computer over the Internet to a Web site 12 of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer (arrows 1); in response to receipt of the request at the Web site 12 of the retailer, transmitting the request from the Web site 12 of the retailer over the Internet to a remote Web site 14 (arrows 2); in response to receipt of the request at the remote site 14, transmitting from the remote site 14 over the Internet to the Web site 12 of the retailer a list of manufacturer incentives (arrows 3); and in response to receipt of the manufacturers incentives at the Web site 12 of the retailer, transmitting over the Internet to the consumer computer the list of manufacturers incentives (arrows 4). See, e.g., Figures 1 and 3 and the

discussion in Appellants' disclosure thereof. Appellants submit that Sloane fails to disclose or suggest the above-noted features of the claimed invention.

Invention (Group 1; Figs. 1, 3)



In contrast, Appellants submit that Sloane is directed to a method, bar code apparatus and system for providing incentives to consumers at a point-of-purchase (POP) in a retail store and fails to disclose or suggest distributing product incentives to consumers over the Internet, as in the claimed invention (emphasis added). Appellants submit that although Sloane discloses processing incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200, as illustrated by the following figure, Sloane fails to disclose or suggest distributing product incentives to consumers over the Internet. See Figures 3a and 3b and the discussion in Sloane thereof.

Sloane (Figs. 3a, 3b)

According to Sloane, a retailer 14 (or sender 16, such as a product manufacturer) designates items that are on sale, or offered with some other consumer promotion or message, and instructs a retailer computer/controller 12 to offer these promotions to a consumer when one of the subject items or related items are selected (i.e., scanned via a bar code scanning device 20) by the consumer at the retail store. The promotion information (arrows 1) is sent to the retailer computer/controller 12 via communication line 200 (i.e., a direct modem connection, an online computer network, such as a Local Area Network (LAN) or a Wide Area Network (WAN), communication over the Internet). The retailer computer/controller 12 is programmed to receive and store the promotional information (arrow 2) from communication line 200 as sent by the retailer 14 or the sender 16. The retailer can then offer the promotions at the POP to a consumer via a bar code scanning device 20. See Figures 2a-2c and 3a-3b and column 7, lines 4-26 of Sloane.

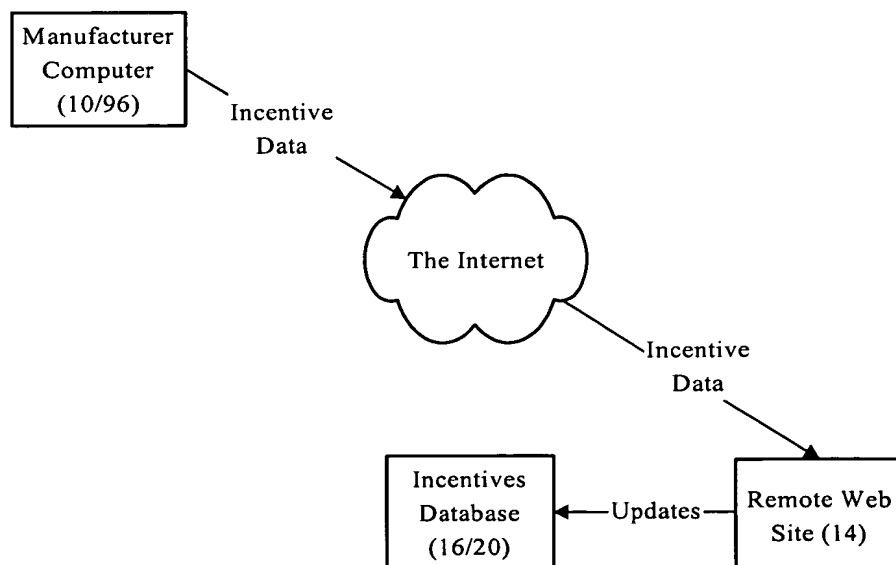
In the above respect, the Examiner asserts, at page 2 of the Office Action, that the claimed invention, as recited in Claims 28 and 40, is anticipated by Sloane, citing column 7, lines 5-10 and 13-26 and column 8, lines 3-7. However, Appellants submit that contrary to the assertion by the Examiner, Sloane fails to disclose or suggest distributing product

incentives to consumers over the Internet, as discussed above and as recited in Claims 28 and 40. Accordingly, Appellants submit that Claims 28 and 40 are not anticipated under 35 U.S.C. §102(e) by Sloane.

GROUP 2: CLAIMS 34 and 46

The present invention, as recited in Claims 34 and 46 and as shown in the below exemplary figure, is directed to a computer network implemented method and system including transmitting from a manufacturer computer 10 over the Internet to a remote Web site 14 manufacturer incentive data defining manufacturer incentives to purchase one of a product and a service offered by a manufacturer; updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data. See, e.g., Figures 1 and 5 and the discussion in Appellants' disclosure thereof. Appellants submit that Sloane fails to disclose or suggest the above-noted features of the claimed invention.

Invention (Group 2; Figs. 1, 5)



In contrast, Appellants submit that although Sloane discloses processing incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200, as previously described, Sloane fails to disclose or suggest updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data (emphasis added). See Figures 3a and 3b and the discussion in Sloane thereof.

In the above respect, the Examiner asserts, at pages 2 and 3 of the Office Action, that the claimed invention, as recited in Claims 34 and 46, is anticipated by Sloane, citing column 7, lines 18-22 and 36-40 and arguing that the above-noted feature is inherent in the Sloane invention. In this respect, the Examiner makes a conclusory statement that since Sloane discloses that the communication line 200 can be the Internet and that since it is traditional practice to present data using a graphical user interface, which presents graphical image data, the above-noted feature is inherent in the Sloane invention. Appellants, however, submit that although it may be traditional practice to present data using a graphical user interface, which presents graphical image data over the Internet, this in-and-of-itself does not teach nor suggest storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives, as in the claimed invention. Accordingly, Appellants submit that Claims 34 and 46 are not anticipated under 35 U.S.C. §102(e) by Sloane.

(B) Claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sloane in view of Hoffman et al. That rejection is untenable and should not be sustained.

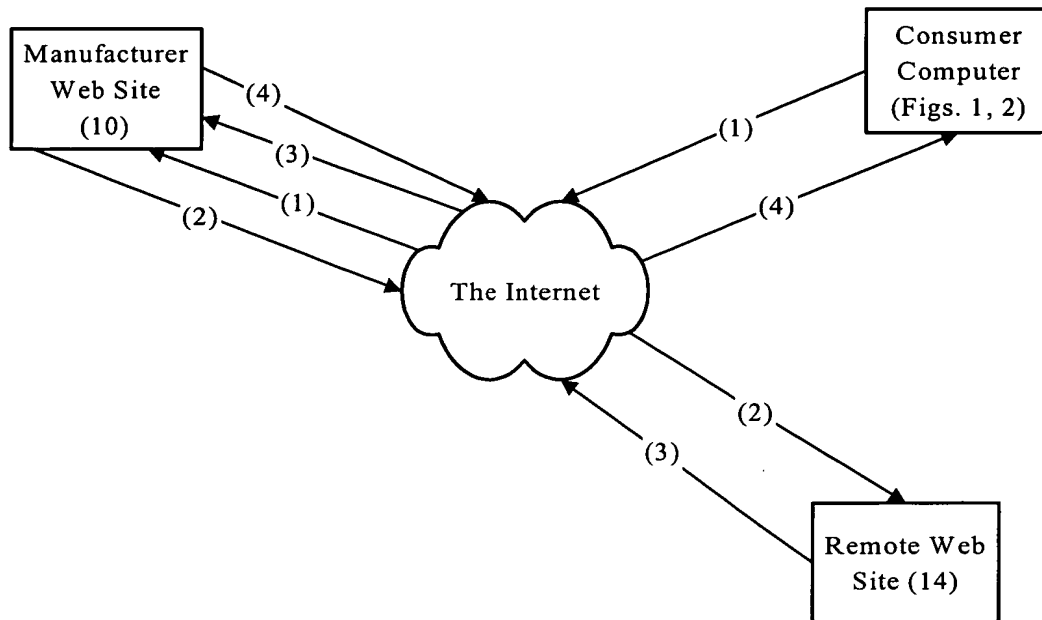
As a preliminary matter, Appellants submit that as evidenced by Pare, Jr. et al (USP 5,870,723), submitted via an IDS herewith and from which Hoffman et al (USP 6,012,039) claims priority, Hoffman et al is not prior art with respect to Applicants' June 12, 1997, priority date since Pare, Jr. et al fails to disclose the features from Hoffman et al cited in and relied on in the Office Action. Accordingly, Appellants submit that a *prima facie* case of obviousness of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49 over Sloane in view of Hoffman et al has not been made since Hoffman et al is not prior art. Nonetheless, Appellants submit that the claimed invention, as recited in Claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49, is patentably distinguishable over Sloane, alone or in combination with Hoffman et al, as is further argued below.

GROUP 3: CLAIMS 24, 36 and 48

The present invention, as recited in Claims 24, 36 and 48 and as shown in the below exemplary figure, is directed to the method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site 10 of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by the manufacturer (arrows 1); in response to the request for manufacturer incentives, transmitting region data from the Web site 10 of the manufacturer over the Internet to a remote Web site 14 (arrows 2); in response to receipt of region data at the manufacturer's Web site 10, transmitting from the remote Web site 14 to the Web site 10 of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer (arrows 3); and transmitting from the Web site 10 of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address

(arrows 4). Appellants submit that Sloane, alone or in combination with Hoffman et al, fails to disclose or suggest all of the noted features of the claimed invention.

Invention (Group 3; Figs. 1, 2)

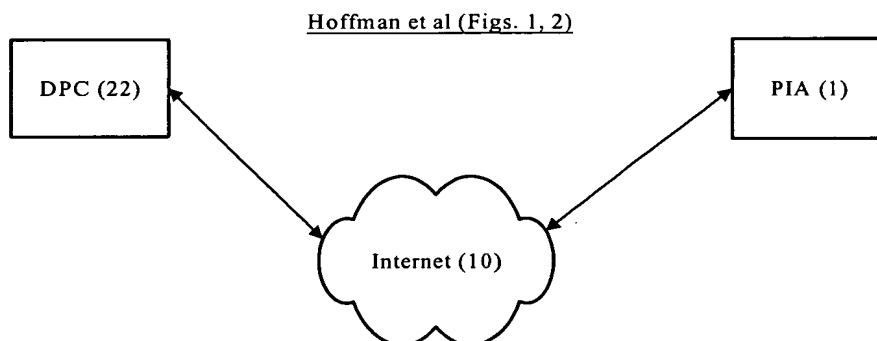


The Examiner asserts at pages 3 and 4 of the Office Action that Sloane teaches all of the above-noted features except “in response to receipt of region data at the manufacturer's Web site, transmitting from the remote Web site to the Web site of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address.” However, Appellants submit that although Sloane discloses processing incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200, as previously described, Sloane fails to disclose or suggest the noted features of the claimed invention. See Figures 3a and 3b and the discussion in Sloane thereof. Appellants submit that Hoffman et al fail to cure the noted deficiencies with Sloane and that Claims 24, 36 and

48 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman et al.

Further, as acknowledged by the Examiner, at page 4 of the Office Action, Sloane fails to teach or suggest “transmitting from the remote Web site to the Web site of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address.” The Examiner attempts to cure such deficiencies in Sloane by applying disclosure from column 11, lines 1-9 and column 13, lines 5-10 of Hoffman et al.

However, Appellants submit that, as is further described with respect to the below figure, Hoffman et al merely disclose a secure incentive distribution system and method between a party identification apparatus (PIA) 1 and a data processing center (DPC) 22 via a communications network 10, such as the Internet and fail to teach or suggest the noted feature of the claimed invention. See Figs. 1 and 2, and column 6, line 28 to column 8, line 41 of Hoffman et al.



In the above respect, Appellants submit that in the invention of Hoffman et al there is no need to send a name and address of a retailer since Hoffman et al teach that the

identification of both parties during an incentives distribution transaction are automatically identified by decrypting provided encryption codes. See column 8, lines 42-52 of Hoffman et al. Accordingly, Appellants submit that, contrary to the assertion by the Examiner, Hoffman et al. fail to teach or suggest the noted feature of the claimed invention and that Claims 24, 36 and 48 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman et al.

GROUP 4: CLAIM 49

Appellants submit that Claim 49 recites substantially the same features as Claims 28 and 40 and is patentably distinguishable over Sloane for substantially the same reasons as discussed above with respect to Group 1. In addition, Appellants submit that Hoffman et al. fail to cure the noted deficiencies with Sloane and that Claim 49 is not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman et al.

In the above respect, the Examiner appears to have failed to indicate where and/or how the above-noted features are disclosed in Sloane and/or Hoffman et al. Accordingly, Appellants submit that no *prima facie* case of obviousness of Claim 49 over Sloane in view of Hoffman et al. has been made.

GROUP 5: CLAIMS 25 and 37

The present invention, as recited in Claims 25 and 37, is directed to the method and system as defined in Claims 24 and 36, wherein the step of transmitting from the remote site 14 further includes transmitting a link to a Web site 12 of the retailer. Appellants submit that Sloane, alone or in combination with Hoffman et al., fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the Examiner, at page 4, lines 10-11 of the Office Action, Sloane fails to teach or suggest the noted features of the claimed invention. The Examiner attempts to cure such deficiencies in Sloane by applying disclosure from column 14, lines 64-67 of Hoffman et al.

However, Appellants submit that Hoffman et al merely disclose a reward recipient locating a Web site of a rewards issuer, but fail to teach or suggest transmitting from a remote site a link to a Web site of a retailer, as in the claimed invention (emphasis added). See column 14, lines 64-67 of Hoffman et al. Accordingly, Appellants submit that Claims 25 and 37 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman et al.

GROUP 6: CLAIMS 27 and 39

The present invention, as recited in Claims 27 and 39, is directed to the method and system as defined in Claims 24 and 36, further includes the steps of transmitting from a consumer computer to a Web site 10 of a manufacturer selection data indicating selection of at least one manufacturer incentive; transmitting from the Web site 10 of the manufacturer to a remote site 14 the selection data; transmitting from the remote site 14 to the Web site 10 of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site 10 of the manufacturer to the consumer computer the details. Appellants submit that Sloane, alone or in combination with Hoffman et al, fails to disclose or suggest the noted features of the claimed invention.

Appellants submit that, contrary to the assertion by the Examiner at page 4, last three lines of the Office Action, although Sloane discloses processing incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200 as previously discussed, Sloane fails to disclose or suggest transmitting from a

consumer computer to a Web site of a manufacturer selection data indicating selection of at least one manufacturer incentive, as in the claimed invention. Appellants submit that Hoffman et al fail to cure the noted deficiencies with Sloane and that Claims 27 and 39 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman et al.

In addition, as acknowledged by the Examiner, at page 5, lines 1-7 of the Office Action, Sloane fails to teach or suggest transmitting from a Web site of the manufacturer to a remote site selection data; transmitting from the remote site to the Web site of the manufacturer details of selected at least one manufacturer incentive; and transmitting from the Web site of the manufacturer to a consumer computer the details, as in the claimed invention. The Examiner attempts to cure such deficiencies in Sloane by applying disclosure from column 6, lines 46-63 of Hoffman et al.

However, Appellants submit that Hoffman et al merely disclose a personal identification apparatus (PIA) 1 capable of performing various secure reward processing functions with a data processing device (DPC) 22, but fail to teach or suggest the noted features of the claimed invention. See column 6, lines 27-65 of Hoffman et al. Accordingly, Appellants submit that Claims 27 and 39 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman et al.

GROUP 7: CLAIMS 29 and 41

The present invention, as recited in Claims 29 and 41, is directed to the method and system as defined in Claims 28 and 40, further includes the steps of transmitting a user identification from a Web site 12 of a retailer over the Internet to a remote Web site 14 in association with a request; and determining manufacturer's incentives to transmit from the

remote Web site 14 to the Web site 12 of the retailer based upon the user identification.

Appellants submit that Sloane, alone or in combination with Hoffman et al, fails to disclose or suggest the noted features of the claimed invention.

Appellants submit that, contrary to the assertion by the Examiner at page 5, lines 11-14 of the Office Action, although Sloane discloses processing incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200 as previously discussed, Sloane fails to disclose or suggest the noted features of the claimed invention. Appellants submit that Hoffman et al fail to cure the noted deficiencies with Sloane and that Claims 29 and 41 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman et al.

(C) Claims 26, 30, 31, 38, 42 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sloane in view of Hoffman et al and further in view of Smolen. That rejection is untenable and should not be sustained.

As a preliminary matter, Appellants submit that, as previously discussed with respect to issue (B) above (Groups 3-7), Hoffman et al is not prior art with respect to Applicants' June 12, 1997, priority date since Pare, Jr. et al, from which Hoffman et al claims priority, fails to disclose the features from Hoffman et al cited in and relied on in the Office Action. Accordingly, Appellants submit that a *prima facie* case of obviousness of Claims 26, 30, 31, 38, 42 and 43 over Sloane in view of Hoffman et al and further in view of Smolen has not been made since Hoffman et al is not prior art. Nonetheless, Appellants submit that the claimed invention, as recited in Claims 26, 30, 31, 38, 42 and 43, is patentably distinguishable over Sloane, alone or in combination with Hoffman et al and Smolen, as is further argued below.

GROUP 8: CLAIMS 26 and 38

The present invention, as recited in Claims 26 and 38, is directed to the method and system as defined in Claims 24 and 36, further includes the step of determining at least one manufacturer's incentive and at least one name and address of a retailer by querying, using region data, a database 16 from a server 14 of a remote Web site. See, e.g., Figs. 1 and 2 and the discussion in Appellants' disclosure thereof. Appellants submit that Sloane, alone or in combination with Hoffman et al and Smolen, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the Examiner, at page 5, penultimate line to page 6, line 4 of the Office Action, Sloane in combination with Hoffman et al fail to teach or suggest the noted features of the claimed invention. The Examiner attempts to cure such deficiencies in Sloane and Hoffman et al by applying disclosure from column 2, line 66 to column 3, line 9 of Smolen.

However, Appellants submit that Smolen merely disclose providing promotions between a consumer system 100 and a promotions processing facility 130 via a communications channel, such as dial-up connection, but fails to teach or suggest determining at least one manufacturer's incentive and at least one name and address of a retailer by querying, using region data, a database from a server of a remote Web site, as in the claimed invention (emphasis added). See column 2, line 66 to column 3, line 9 and column 7, lines 12-24 of Smolen. Accordingly, Appellants submit that Claims 26 and 38 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman et al and further in view of Smolen.

GROUP 9: CLAIMS 30 and 42

The present invention, as recited in Claims 30 and 42, is directed to the method and system as defined in Claims 28 and 40, further includes the step of transmitting from a consumer computer over the Internet to a Web site 12 of a retailer region data. See, e.g., Figs. 1 and 3 and the discussion in Appellants' disclosure thereof. Appellants submit that Sloane, alone or in combination with Hoffman et al and Smolen, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the Examiner, at page 5, penultimate line to page 6, line 4 of the Office Action, Sloane in combination with Hoffman et al fail to teach or suggest the noted features of the claimed invention. The Examiner attempts to cure such deficiencies in Sloane and Hoffman et al by applying disclosure from column 2, line 66 to column 3, line 9 of Smolen.

However, Appellants submit that Smolen merely disclose providing promotions between a consumer system 100 and a promotions processing facility 130 via a communications channel, such as dial-up connection and generating a user profile including demographic information, such a phone number of the consumer, but fails to teach or suggest the noted feature of the claimed invention. See column 2, line 66 to column 3, line 9, column 4, lines 55-67 and column 7, lines 12-24 of Smolen. Accordingly, Appellants submit that Claims 30 and 42 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman et al and further in view of Smolen.

GROUP 10: CLAIMS 31 and 43

The present invention, as recited in Claims 31 and 43, is directed to the method and system as defined in Claims 30 and 42, wherein the region data is postal code data. See, e.g.,

Figs. 1 and 3 and the discussion in Appellants' disclosure thereof. Appellants submit that Sloane, alone or in combination with Hoffman et al and Smolen, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the Examiner, at page 6, lines 10-11 of the Office Action, Sloane in combination with Hoffman et al fail to teach or suggest the noted features of the claimed invention. The Examiner attempts to cure such deficiencies in Sloane and Hoffman et al by applying disclosure from column 4, line 64-67 of Smolen.

However, Appellants submit that Smolen merely disclose providing promotions between a consumer system 100 and a promotions processing facility 130 via a communications channel, such as dial-up connection and generating a user profile including demographic information, such a phone number of the consumer, but fails to teach or suggest the noted feature of the claimed invention. See column 2, line 66 to column 3, line 9, column 4, lines 55-67 and column 7, lines 12-24 of Smolen. Accordingly, Appellants submit that Claims 31 and 43 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman et al and further in view of Smolen.

Based on the above discussion, Appellants submit that Claims 24-31, 34, 36-43, 46, 48 and 49 are patentably distinguishable under 35 U.S.C. §§102, 103 over the applied references.

For all the above reasons, it is respectfully requested that the rejection of Claims 24-31, 34, 36-43, 46, 48 and 49 be REVERSED.

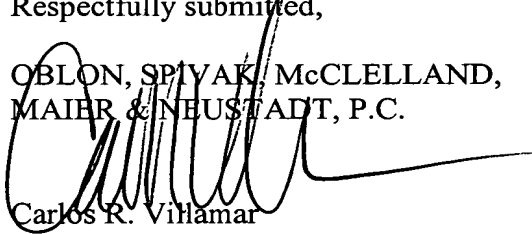
IX. CONCLUSION

Appellants submit that (i) the prior art neither discloses nor suggests the system, method and computer program product of the present invention, as recited in Claims 24-31,

34, 36-43, 46, 48 and 49, (ii) no *prima facie* case of obviousness of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49 and Claims 26, 30, 31, 38, 42 and 43 over Sloane in view of Hoffman et al and/or Smolen has been made since Hoffman et al is not prior art, (iii) no *prima facie* case of obviousness of Claim 49 over Sloane in view of Hoffman et al has been made since the Examiner appears to have failed to indicate where and/or how the claimed features are disclosed in Sloane and/or Hoffman et al. Accordingly, it is respectfully requested that all the rejections still pending in the present Office Action be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Carlos R. Villamar
Registration No. 43,224



22850

(703) 413-3000

Fax #: (703) 413-2220

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APPENDIX I

CLAIMS ON APPEAL

24. A computer network implemented method, comprising the steps of:
transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

25. The method according to claim 24, wherein said step of transmitting from said remote site further comprises transmitting a link to a Web site of said retailer.

26. The method according to claim 24, further comprising the step of determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

27. The method according to claim 24, further comprising the steps of:
transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

transmitting from said Web site of said manufacturer to said remote site said selection data;

transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

transmitting from said Web site of said manufacturer to said consumer computer said details.

28. A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

29. The method according to claim 28, further comprising the steps of:

transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

30. The method according to claim 28, further comprising the step of transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

31. The method according to claim 30, wherein said region data is postal code data.

34. A computer network implemented method, comprising the steps of:

transmitting from a manufacturer computer over the Internet to a remote Web site manufacturer incentive data defining manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to said manufacturers incentives with said manufacturer incentive data.

36. A computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

means for, in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

means for, in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

means for transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

37. The system according to claim 36, wherein said means for transmitting from said remote site said list further comprises means for transmitting a link to a Web site of said retailer.

38. The system according to claim 36, further comprising means for determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

39. The system according to claim 36, further comprising:

means for transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

means for transmitting from said Web site of said manufacturer to said remote site said selection data;

means for transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

means for transmitting from said Web site of said manufacturer to said consumer computer said details.

40. A computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

means for, in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

means for, in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

means for, in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

41. The system according to claim 40, further comprising:

means for transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

means for determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

42. The system according to claim 40, further comprising means for transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

43. The system according to claim 42, wherein said region data is postal code data.

46. A computer network implemented system, comprising:

means for transmitting from a manufacturer computer over the Internet to a remote Web site manufacturer incentive data defining manufacturer incentives to purchase one of a product and a service offered by a manufacturer; and

means for updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to said manufacturers incentives with said manufacturer incentive data.

48. A computer program product for implementing on a network a method, comprising the steps of:

in response to receiving at a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

49. A computer program product for performing a computer network implemented method, comprising the steps of:

in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

APPENDIX II

PROPOSED FINDINGS OF FACT AND CONCLUSIONS OF LAW

A. Findings of fact

1. A computer network implemented system and method of the present invention, as recited in Claims 28, 34, 40 and 46, is nowhere disclosed or suggested in Sloane.

2. As evidenced by Pare, Jr. et al (USP 5,870,723), submitted via an IDS herewith and from which Hoffman et al (USP 6,012,039) claims priority, Hoffman et al is not prior art with respect to Applicants' June 12, 1997, priority date since Pare, Jr. et al fails to disclose the features from Hoffman et al cited in and relied on in the Office Action.

3. A computer network implemented system, process, and computer program product including features as recited in Claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49 is nowhere disclosed or suggested by Sloane, alone or in combination with Hoffman et al.

4. A computer network implemented system, process, and computer program product including features as recited in Claims 26, 30, 31, 38, 42 and 43 is nowhere disclosed or suggested by Sloane, alone or in combination with Hoffman et al and/or Smolen.

B. Conclusions of law

1. The subject matter of Claims 28, 34, 40 and 46 is not anticipated by Sloane.

2. A *prima facie* case of obviousness of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49 and Claims 26, 30, 31, 38, 42 and 43 over Hoffman et al and/or Smolen has not been made since Hoffman et al is not prior art.

3. A *prima facie* case of obviousness of Claim 49 over Sloane in view of Hoffman et al has been made since the Examiner appears to have failed to indicate where and/or how the claimed features are disclosed in Sloane and/or Hoffman et al.

4. The subject matter of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49 and Claims 26, 30, 31, 38, 42 and 43 is not obvious over Sloane in view of Hoffman et al and/or Smolen.

5. The claimed invention, as recited in Claims 24-31, 34, 36-43, 46, 48 and 49, is not unpatentable under 35 U.S.C. §§102, 103.

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